

## **REMARKS**

Applicants have studied the Office Action dated February 13, 2003 and have made amendments to the claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, Claims 1-34 remain pending. Claims 1-3, 5, 7-9, 11-18, 20-21, 23-24, 27-28, and 34, have been amended. Reconsideration and further examination of the pending claims in view of the above amendments and the following remarks is respectfully requested.

### **Rejection under 35 U.S.C. §103(a)**

Examiner rejected Claims 1-30 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Liao et al (Liao) (U. S. Patent No. 5,988,902) in view of Gerpheide (U. S. Patent No. 6,507,338).

Applicants have amended Claims 1-3, 5, 7-9, 11-18, 20-21, 23-24, 27-28, and 34, to more clearly recite the presently claimed invention and with proper antecedent basis. The amendments were not intended to add any limitation to the claims or for patentability of the claims in view of the cited prior art. No new matter was added.

Liao shows the touchpad 42 partitioned into portions, such as first portion 42a for button functions and a second portion for cursor movement. See Liao, for example, column 4, lines 55-59, and column 5, lines 35-40, and FIG. 2. Applicants agree with Examiner that Liao does not teach or suggest the touchpad being disposed along at least a portion of an outside edge (or along a perimeter) of the housing.

Gerpheide shows a touchpad 60 with a planar top surface 62 being divided into regions, such as two regions that are distinguished by touch. The border region 64 makes a continuous loop around a perimeter of the top surface 62 of the touchpad 60. The inner region 66 is separated from the border region 64 by a ridge 70 that is slightly

raised above the surface 62 and easily discernible by touch. See Gerpheide, for example, FIGs. 4A and 4B, and column 7, lines 56-64, and column 8, lines 5-10. The touchpad regions 66 and 64 can be used by a user to extend a scroll function across a display. See Gerpheide, for example, column 9, lines 25-41.

Gerpheide clearly does not teach or suggest a touchpad being disposed along at least a portion of an outside edge (or along a perimeter) of the housing.

The presently claimed invention is directed to a touchpad input device, a method, and an electronic device, for utilizing touch input about at least a portion of at least one outside edge of a housing. Optionally, the touch input may be along a perimeter of the housing along the at least one outside edge of the housing. This overcomes problems with the prior art by providing an efficient input device that is easy to use and allows the overall size and weight of an electronic device to be minimized. It solves a need in the art by providing touch input along at least one outside edge of a housing. The edge is a very valuable piece of virtually untapped real estate on the outside of the housing of electronic devices. Using tactile feel, the outside edge of the housing is also one of the most easily located areas on an electronic device. See the originally filed specification, on page 10, lines 7-20.

As noted by the Examiner, Liao does not teach that the touchpad is disposed along at least a portion of an outside edge (or along a perimeter) of the housing. As discussed above, Gerpheide clearly does not teach or suggest a touchpad being disposed along at least a portion of an outside edge (or along a perimeter) of the housing. On the other hand, the presently claimed invention teaches, as recited for independent Claims 1 and 25, and for all dependent claims depending therefrom, respectively, the touchpad being disposed along at least a portion of the at least one outside edge of a housing. Moreover, as recited for independent Claim 19, and for all dependent claims depending therefrom, a method comprises the step of touching about the outside edge of a housing. There is no teaching or suggestion in any of the cited references, or any combination thereof, of the touchpad being disposed along at least a

portion of the at least one outside edge of a housing or of the touching about the outside edge of a housing as recited for the presently claimed invention.

When there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicant's own specification. As the Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cri. 1992).

For the foregoing reasons, all of the present claims 1-34, including the amended Claims 1-3, 5, 7-9, 11-18, 20-21, 23-24, 27-28, and 34, distinguish over the cited references or any combination thereof. Therefore, the rejection of these claims under 35 U.S.C. §103(a) should be withdrawn. Applicants believe that all of the claims are in allowable form, and kindly urge Examiner to allow the claims to issue.

#### **Allowable Subject Matter**

Examiner objected to Claims 31-33 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

In view of the amendments to the Claims 1-3, 5, 7-9, 11-18, 20-21, 23-24, 27-28, and 34, and the arguments above, and since Claims 31-33 depend from independent Claim 25 that recites "a touchpad disposed along at least a portion of at least one outside edge of a housing", Applicants believe that claims 31-33 are now allowable in their present form. Applicants respectfully submit that the Examiner's objection has been overcome based on the amendments to the claims and remarks above.

Applicants request that the Examiner withdraw the objection and allow Claims 31-33 in their present form.

### **Conclusion**

The foregoing is submitted as full and complete response to the Official Action mailed February 13, 2003, and it is submitted that Claims 1-34 are in condition for allowance. Reconsideration of the rejection and objection are requested. Allowance of Claims 1-34 is earnestly solicited.

The present application, after entry of this amendment, comprises thirty-four (34) claims, including three (3) independent claims. Applicants have previously paid for thirty-four (34) claims, including three (3) independent claims. Applicants, therefore, believe that an additional fee for claims is currently not due.

However, a petition for a two month extension of time to file this Response has been attached. The Commissioner is authorized to charge the two month extension fee in the amount of \$410, or if this fee amount is insufficient, then the Commissioner is authorized to charge the appropriate fee amount to prevent this application from becoming abandoned, to Deposit Account 50-1556.

**If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.**

The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 09-0441.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

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